

Remarks/Arguments

Entry of the foregoing amendment and reconsideration of this application is respectfully requested. It is respectfully submitted that the foregoing claims define the present invention in a way that is not disclosed in or obvious from the cited references.

Initially, the courtesy of telephone interviews between the undersigned, examiner Thomas, and the undersigned on 12 January 2006, March 17 and March 18, 2006, is respectfully acknowledged, and it is noted that this amendment is filed as a result of those telephone interviews. As indicated in the interview summary of January 12, 2006, the examiner had placed two phone calls to the undersigned that day. The first phone call suggested certain changes that are included in claim 15 above (and the withdrawal of claim 16) to place the application in condition for allowance (in that call the examiner had indicated that if applicant adopted the examiner's suggestion of the use of the language "consisting essentially of a mixture that includes cement, expanded polystyrene and water" (emphasis added), such language would not have excluded the addition of fly ash and/or reinforcement that make up applicant's preferred composition. In the second phone call, on January 12, 2006, the examiner indicated that in view of certain references that were of record (undersigned later learned that they were the Fugazzi and EPO references), the examiner felt he needed to withdraw the indication of allowance and issue a new office action based on the new references.

The examiner then issued the final office action of January 19, 2006, relying primarily on Fugazzi and the EPO application to Weinstein. On March 17, 2006, undersigned faxed the attached document (Exhibit A) to the examiner, and the examiner and the undersigned discussed this application on March 17 and 18, 2006. In that latter discussion, undersigned noted that both Fugazzi and the EPO disclosures were for complete prefabricated tile countertops that were installed in that form, whereas the present invention related to a preformed, self sustaining **tile substrate** that was intended to be installed on a base, to avoid the need for a plywood type backer, and for one or more tiles

to then be installed on the tile substrate. Thus, the present invention was directed to a preformed tile substrate that would avoid the need for a plywood backer in a build up countertop.

In the discussions of March 17 and 18, 2006, the examiner appeared to the undersigned to recognize the differences in concept between the present invention and Fugazzi and the EPO reference, and it was the examiner's suggestion that such differences could best be brought out by defining the present invention in method claim language. The examiner felt that with method claim language, which defined applicant's prefabricated, self sustaining tile substrate that is directly applied to a base, and the subsequent application of tiles to the prefabricated tile substrate the present invention could be distinguished from the complete prefabricated countertops of Fugazzi and the EPO reference.

Accordingly, according to the foregoing amendment, applicant has presented new claims 19 and 20 directed to the applicant's concept of providing the prefabricated, self sustaining tile substrate, applying that prefabricated, self sustaining tile substrate directly to a base, and thereafter applying one or more tiles to the preformed self sustaining tile substrate. With such language, it is respectfully submitted the present invention is fundamentally different from and not obvious from, the Fugazzi or EPO references, or any of the other cited references. In order to provide the invention of Claims 19 and 20, one would have to conceive of a completely new paradigm for constructing a built up countertop, rather than the complete prefabricated tile counter of Fugazzi or the EPO reference, and such a new paradigm would be apparent only from the present disclosure, and not Fugazzi, the EPO reference or any of the other cited references. Therefore it is respectfully submitted claims 19 and 20 are clearly in condition for allowance. Applicant would further note that in claim 19 applicant has adopted the examiner's suggestion of the use of the language "consisting essentially of a mixture that includes cement, expanded polystyrene and water", in reliance on the examiner's position that such language would not have excluded the addition of fly ash and/or reinforcement that make up applicant's preferred composition.

Finally, applicant has presented claims 15, 17 and 18, with amendments that direct the claims to a tile substrate, and also adopt the examiner's suggestion of the first phone conference of January 12, 2006, and respectfully asks the examiner to consider those claims with the foregoing amendments. In the applicant's fax of March 17, 2006 (Exhibit A) undersigned sought to explain why the Fugazzi and EPO references did not disclose or suggest the invention of those claims, and applicant's remarks set forth in Exhibits A are respectfully incorporated herein by reference. It is further noted that those claims are expressly limited to a "tile substrate", as opposed to the preformed counter of Fugazzi or the EPO reference. For those reasons, it is respectfully submitted claims 15, 17 and 18 are also patentably distinct from the cited references. Applicant would further note that in claim 15 applicant has adopted the examiner's suggestion of the use of the language "consisting essentially of a mixture that includes cement, expanded polystyrene and water", in reliance on the examiner's position that such language would not have excluded the addition of fly ash and/or reinforcement that make up applicant's preferred composition.

It is respectfully submitted that all remaining claims are allowable. Favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "Lawrence R. Oremland". The signature is written in a cursive, flowing style.

Lawrence R. Oremland
Reg. No. 27,046
Attorney for Applicant

Exhibit A to RCE Amendment in application serial number 10/619,283

Privileged/Confidential

LAWRENCE R. OREMLAND, P.C.
5055 E. Broadway Blvd., Suite C-214
Tucson, Arizona 85711

Telephone (520)-747-0999
Facsimile (520) 747-0977
larry@oremland.com

FACSIMILE TRANSMITTAL SHEET

TO:	FROM:
Examiner Alexander Thomas	Larry Oremland
COMPANY:	DATE:
US Patent and Trademark Office	3/17/2006
FAX NUMBER:	TOTAL NO. OF PAGES INCLUDING COVER:
571-273-1502	6
PHONE NUMBER:	SENDER'S REFERENCE NUMBER:
RE:	YOUR REFERENCE NUMBER:
Serail Number 10/619,283	

☒ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☒ PLEASE REPLY ☐ PLEASE RECYCLE

NOTES/COMMENTS:

Dear Examiner Thomas,

I have attached a document that may help explain our view of the refereces and the claims, if amended in the way you had originally proposed.

I hope this may help facilitate any discussions we have Saturday or Monday.

Thank you.

Larry Oremland

Dear Examiner Thomas,

Thanks for returning my call yesterday. I thought it might make sense if I summarized our short discussion, in case it will make things more efficient to handle between now and Monday, to see where we are. I also thought it might be useful if I summarized our reaction to the claims and the references relied upon, in the hopes that will also help advance the prosecution.

Regarding the claims I am hoping to discuss with you, as you may recall, on January 12, 2005, you called me and suggested claim modifications that could be made by examiner's amendment to place the case in condition for allowance. According to my notes, you suggested that claim 16 be canceled, and that claim 15 be amended to replace "comprising" both instances with "consisting essentially of". You explained that such an amendment would clearly limit the claims to a self supporting article that excluded the use of a plywood substrate (applicant's primary objective has been to define a tile substrate that was preformed, self supporting and excluded the use of a plywood backer that was typically found in built up counter top structures), but would not exclude inclusion of fly ash, reinforcement material, etc. in the self supporting article. I had reviewed those suggestions with the applicant that day, and had the applicant's approval to them, but before I could call you, you called and left a message that in light of some art that was in the file, that you needed to withdraw that suggestion, and issue another office action.

In the new office action, Fugazzi is now the primary reference relied upon. Fugazzi is relied upon as disclosing solid surface material 32 deemed equivalent to claimed tile, laminated to a fiber reinforced concrete layer 34 comprising Portland cement, water, fly ash and aggregate. The EPO patent is relied upon as disclosing a preformed, self supporting article, and the office action states that it would have been obvious to one of ordinary skill in the art to apply the countertop of the primary reference (Fugazzi) on a cabinet base with vertical walls and an opening as taught by the secondary (EPO) reference.

We would respectfully disagree that Fugazzi and the EPO reference would render the finally rejected claims obvious. Moreover, if the amendments that were originally suggested to us in our phone conversation were made, we think the patentability of the claims would be even more apparent. Thus, in this fax, I would like to comment on why we think the claims (especially the claims that were suggested to us) are not obvious from Fugazzi and the EPO reference. I will also comment on the suggestion that I made today, to enable us to avoid deciding whether to petition the propriety of the final rejection (because we would have to take that action by Monday). Specifically, my suggestion was that if you could agree that if we filed the claims suggested to us in the January 12 phone call, that at the least those claims would be entered for appeal purposes, applicant would not feel the need to decide whether a petition is appropriate. Thus, I am hoping we can get a response to that suggestion over the weekend if possible, so that applicant can decide its options.

Regarding the claims and the analysis in the office action, both references primarily relied upon in the office action, Fugazzi and the EPO document, disclose structures that are intended as complete countertops, rather than substratum for tiles, which is the object of the present invention. Thus, neither Fugazzi nor the EPO document discloses or suggests anything that would be a self supporting article that is designed to support tiles, as specifically defined in claim 14.

More specifically, it appears that Fugazzi is being relied upon to meet the recitation of a "preformed, self supporting article". Thus, either the combination of the solid surface material 32 and the concrete mixture 34, or the concrete mixture 34 alone, would have to be the preformed self supporting article defined in the claims. Moreover, that preformed, self supporting article would have to support tiles, as defined in claim 14. We can't find anything in Fugazzi that would suggest that Fugazzi's mixture 34 of cement, water, fly ash and aggregate is a "preformed, self supporting article" upon which one or more tiles could be supported. As we read Fugazzi, the mixture 34 is secured to the solid surface 32 material by using the solid surface material as a mold into which the mixture 34 is applied. Thus, if Fugazzi's structure that includes **both** the solid surface material 32 and the concrete layer 34 (which is bonded to the material 32 using the material 32 as a mold) is considered the "preformed, self supporting article", it could not meet the recitation of claim 14 that one or more tiles are supported **on** the preformed, self supporting article. On the other hand, if the mixture 34 that is bonded to the solid surface material 32 is considered the "preformed, self supporting article", there is no basis in Fugazzi to draw that conclusion, since the solid surface material 32 is intended to form a mold for the mixture 34. Therefore, there is nothing in Fugazzi that would even remotely suggest the mixture 34 that is bonded to the solid surface material 32 is a "preformed, self supporting article".

Thus, we submit that Fugazzi does not disclose or suggest the "preformed, self supporting article" defined in the claims, particularly the preformed, self supporting article that supports tiles, as defined in claim 14. Moreover, there is nothing in the EPO reference that would motivate one of ordinary skill to provide the preformed, self supporting article defined in claims 15 and 14. The EPO reference also discloses a unitary tiled countertop structure that is intended as a complete countertop that includes a complete tiled structure that is bonded to internal structure, and effectively completes the tiled countertop structure. Thus, there is nothing in the EPO reference that discloses or suggests the preformed, self supporting article that is designed to support tiles, as defined in claims 15 and 14. In addition, whatever is inside the tiled countertop of the EPO reference is **not** a preformed, self supporting article that consists essentially of cement, water and expanded polystyrene.

Moreover, there is no evidence or analysis as to the basis for the rejection of claim 17. That claim defines the preferred formulation that produces the preformed self supporting article. A version of that formulation has been before the PTO from the original claims, although the language of claim 17 is believed to improve that language to provide applicant with the scope of protection to which this application should be entitled. There is no specific reference applied against claim 17, and the statement that "it would be

obvious to one of ordinary skill in the art to provide the cement composition use [sic] in the primary reference product and to vary the amounts of the various ingredients to provide optimum physical properties” does not address that subject matter, because the mixture of Fugazzi is not disclosed or suggested as providing a preformed, self sustaining article (and is certainly not disclosed or suggested as providing a preformed self sustaining article that is designed to support tiles).

I hope this discussion is helpful to you in evaluating our understanding of the references and the claims, and I hope that in any discussions we can explore whether we agree or disagree on the relationship of the references and the claims, particularly the claims with the revisions you suggested in our January 12 phone call. I also hope that if we still have a disagreement on the patentability of the claims, that we would at the least know if you would enter an amendment along the lines you suggested in our January 12 phone call for appeal purposes. For your information, if we did feel it appropriate to petition the propriety of the final rejection, we would base our petition primarily on MPEP 706.07 which states:

706.07 Final Rejection [R-3]

37 CFR 1.113 Final rejection or action.

****>**

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.<

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution; Ex parte Hoogendam, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm'r Pat. 1939).

It seems to us that since we explained in the original phone interview that we were trying to direct the claims to a preformed, self supporting article that was designed as a tile substrate for a cabinet style base with vertical walls and an opening between the walls, and which excluded a plywood substratum of the type found in built up countertops, and your suggestions of January 12, 2006 were, we believe, intended to better define that concept, and also since the Fugazzi and EPO references were cited but not applied in the

Application No. 10/619,283
Reply to Office Action Dated: January 19, 2006
Exhibit A

original office action, that applicant should have the opportunity to have such claims evaluated and in the record, if an appeal were to be necessary.

In any event, I hope this fax adequately explains our position, and I hope we will have an opportunity to discuss this case with you by Monday.



Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

DATE: July 19, 2006

I hereby certify that the enclosed Transmittal for filing a RCE Application Entitled: A Preformed Self Supporting Tile Substratum for Cabinets, Vanities, Bar Tops and Other forms of Counter Tops, being filed on the date indicated above, and the attached documents (stated below), are being deposited as "First Class Mail" on this date with the United States Postal Service in an envelope addressed to:

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Documents Enclosed Include:

1. RCE Application Transmittal (1 page in duplicate);
2. Amendment (12 pages);
3. Request for three month extension of time (1 page in duplicate);
4. Check in the amount of \$905.00 for the RCE Filing Fee and Three month Extension Fee;
5. Certificate of Mailing Sheet; and
6. Return Receipt Postcard

By: _____

Lawrence R. Oremland

Lawrence R. Oremland

Signature of person depositing above mentioned documents